

#### IV. REMARKS

1. Claims 1, 7 and 8 are amended.
2. Claims 1, 7 and 8 have been amended to include the subject matter of claim 9. Therefore, it is respectfully submitted that the changes to the claims should not necessitate additional consideration and/or search. Entry of this amendment is respectfully solicited.
3. Claims 1-8, 11-13 and 15 as amended, are not anticipated by International Publication WO 96/35306.

The Examiner has already admitted that WO 96/35306 does not teach the step of storing the pre-determined list in a central element, whereby claim 9 is not anticipated by the international publication. Therefore, amended claim 1 is clearly not anticipated by the international publication. Kingdon does not overcome the above-mentioned deficiency.

The Examiner states that Kingdon teaches storing in a central element a pre-determined list for each respective radio transmitter. This is not an accurate statement with respect to Applicant's invention. The Examiner is right in that Kingdon teaches storing a pre-determined list in a central element.

However, the pre-determined list of Kingdon is unlike Applicants. In Kingdon, the list is a list of valid agencies, which are authorized to position mobile devices (column 4, rows 57-66), and not a list of radio channels as recited in claim 1 of Applicants' invention. Additionally, Kingdon teaches using a pre-determined list of mobile identities, which can be cross-checked against a list of agencies that are allowed to position

each mobile unit (column 5, rows 12-25). Kingdon does not even mention a pre-determined list of radio-channels.

Further, Kingdon does not teach transmitting to a mobile communication device data related to the pre-determined list. Instead, in Kingdon, the pre-determined list is used for evaluating. The list is only used to determine whether an agency is allowed to position a mobile device. The actual positioning of the mobile device is conducted only after that, but unlike Applicants' invention, the data from this list is not transferred to the mobile device. Kingdon does not teach a specific way to position the mobile device.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, neither WO 96/35306 or Kingdon disclose or suggest each feature of Applicants' invention as claimed. Thus, a *prima facie* case of obviousness cannot be established.

Applicants also submit that there is no suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of either WO 96/35306 or Kingdon. The references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the reference as proposed for purposes of

35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over WO 96/35306 in view of Kingdon under 35 U.S.C. §103(a) is not established.

Therefore, it would not have been obvious to a person skilled in the art to apply the teachings of Kingdon to an actual positioning process. On the contrary, starting from WO 96/35306 and taking the teachings of Kingdon into account, a person skilled in the art would have come up with a positioning solution according to WO 96/35306, wherein it is additionally verified that the positioning of a mobile device is allowable. Thus a person skilled in the art could not have come up with the method of now amended claim 1 by combining teachings of WO 96/35306 and Kingdon.

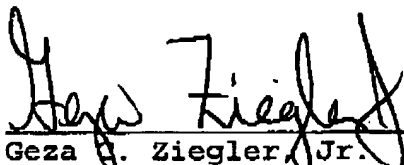
4. Claims 9-10 and 14 are not unpatentable over WO 96/35306 in view of Kingdon under 35 U.S.C. §103(a). These claims depend from claim 1, which should be allowable for the reasons noted above. Thus, claims 9-10 and 14 should be allowable at least in view of the dependencies.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should

any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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10 JUNE 2003  
Date

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